

Application No. 09/833,546

**REMARKS**

Claims 1 and 3 to 25 are pending in the application. The claims stand rejected under 35 U.S.C. §103(a) as being unpatentable over Parker et al. (U.S. Patent 5,721,032) in view of Fuller et al. (U.S. Patent 6,096,470) and further in view of Sakakibara et al. (U.S. Patent 5,663,283) and Handbook of Thermoset Plastics (2<sup>nd</sup> Edition) 1998.

Applicants continue to traverse the rejection of the claims. In response to Applicants' position as set forth in the previous Amendment, the Examiner has stated that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Applicants point out that an analysis of an obviousness rejection based on a combination of references necessarily entails an analysis of each of the references before the combination of the teachings thereof can be considered. Accordingly, Applicants are of the position that an analysis of the individual references, including an analysis of what each reference does and does not teach, is entirely appropriate in the context of a rejection based on a combination of the references.

Further in response to Applicants' position as set forth in the previous Amendment, the Examiner has stated that Parker et al. shows a polyamide used as an adhesive, and in Example 1 states polyamide melting into the seamed area of the belt, and that therefore the alcohol soluble polyamide is taught as added to the interlocking ends to bind two ends together. Applicants point out, however, that the Examiner has not pointed out any teaching in Parker et al. to the effect

Application No. 09/833,546

that the polyamide therein is alcohol soluble. Parker et al. teaches application by heat and/or pressure of a seam strength enhancing material which may be a polyamide; the reference does not appear to discuss solubility of this polyamide in solvents.

Further in response to Applicants' position as set forth in the previous Amendment, the Examiner has stated that Parker et al. shows polyamide used in the seams and Fuller et al. shows that alcohol soluble polyamide as adhesive in belts, teaching the same chemical structure. First of all, Applicants point out that Fuller et al. does not teach the same chemical structure as Parker et al. because Parker et al. does not appear to teach any specific chemical structure; rather, this reference simply recites "polyamide". Secondly, as Applicants stated in the previous Amendment, Fuller et al. does not teach or suggest the use of a polyamide as an adhesive. This reference teaches that the substrate of a photoconductor can be, among other materials, a polyamide. This reference further teaches that an optional adhesive layer can be contained in the photoreceptor on the hole blocking layer, and teaches that typical adhesive layer materials include polyesters, polyurethanes, and the like; polyamides are not included in this list. This reference further teaches that, among other materials, polyamides can be used as the polymeric film forming binder material in the matrix in the charge generating layer. In Example I, the charge blocking layer contains a polyamide. The reference discusses alcohol soluble polyamides in the context of an overcoat layer applied to the undried charge transport layer of the photoreceptor. The Examiner has not pointed to anything in this reference that would teach or suggest to one

Application No. 09/833,546

of ordinary skill in the art that these alcohol soluble polyamides would be desirable or effective as adhesives to bind together two ends of a belt in a puzzle-cut seam. As the Examiner has stated, the term "polyamide" encompasses many kinds of polyamides; one of ordinary skill in the art would not be motivated to select the specific alcohol soluble polyamides recited in the instant claims as an adhesive based on the teachings of these references viewed in combination.

The Examiner appears to have considered various portions of the references cited, in each instance viewing the cited portion in isolation from the context of the entire reference, and combined these isolated portions to arrive at the present invention with the benefit of hindsight. Using hindsight or applying the benefit of the teachings of the present application when determining obviousness, however, is impermissible; the references applied must be reviewed without hindsight, must be reviewed as a whole, and must suggest the desirability of combining the references. Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 221 U.S.P.Q. 481 (Fed. Cir. 1984). None of the cited references suggests or teaches the desirability of combining the elements of the present invention as claimed. Obviousness cannot be established by combining references to arrive at the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. In re Gelger, 2 U.S.P.Q. 2d 1276 (Fed. Cir. 1987); Carella v. Starlight Archery and Pro Line Co., 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 U.S.P.Q. (BNA) 929 (Fed. Cir. 1984). When prior art references require selective combination to render obvious a subsequent invention, there

Application No. 09/833,546

must be some reason for the combination other than the hindsight gleaned from the invention itself. Uniroyal Inc. v. Rudkin Wiley Corp., \_\_\_ F. 2d \_\_\_, 5 U.S.P.Q. 2d 1435 (Fed. Cir. 1988); Interconnect Planning Corp. v. Fell, 774 F. 2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention. Uniroyal Inc. v. Rudkin Wiley Corp., \_\_\_ F. 2d \_\_\_, 5 U.S.P.Q. 2d 1435 (Fed. Cir. 1988); W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F. 2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). As the Court of Appeals for the Federal Circuit recently stated in Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal Inc., 56 U.S.P.Q. 2d, 1641 (Fed. Cir. 2000) at 1644:

This court has recently reemphasized the importance of the motivation to combine:

As this court has stated, "virtually all (inventions) are combinations of old elements." Therefore, an examiner (or accused infringer) may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner (or accused infringer) to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

....

...To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against

Application No. 09/833,546

FAX RECEIVED  
AUG 06 2003  
GROUP 1700

hindsight analysis and rote application of the legal test for obviousness.

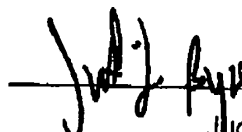
In re Rouffet, 149 F.3d 1350, 1357-58, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted).

For the instant application, the Examiner also appears to have attempted to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. This method is clearly impermissible. Nothing in any of the cited references teaches or suggests the combination of elements recited in the instant claims.

Applicants believe that the foregoing distinctions place the claims in condition for allowance, and accordingly respectfully request reconsideration and withdrawal of all grounds for rejection.

In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Applicant(s) attorney, Judith L. Byorick, at Telephone Number (585) 423-4564, Rochester, New York.

Respectfully submitted,

  
\_\_\_\_\_  
Judith L. Byorick  
Attorney for Applicant(s)  
Registration No. 32,606  
(585) 423-4564

JLB/cw

August 5, 2003  
Xerox Corporation  
Xerox Square 20A  
Rochester, New York 14644